



# UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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Mailed: 10/21/02

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Paper Number 20

In re Application of :  
Thomas Gilchrist et al. : DECISION ON  
Serial No.: 09/424,811 : PETITION  
Filed: November 30, 1999 :  
For: METHOD OF PRODUCING WATER-SOLUBLE GLASS FIBERS :

This is a Decision on the PETITION filed under 37 C.F.R. 1.181 on July 23, 2002. The PETITION requests three different actions be granted.

First, applicants seek an order suspending the appeal and remanding the application to the examiner with instructions that the examiner (i) give full consideration on the merits to applicants' June 23, 2000 Information Disclosure Statement, the materials attached thereto and the Form PTO-1449 (Modified) submitted on July 2, 2001, (ii) apply the non-considered references to applicants' pending claims if the examiner deems those references pertinent (with applicants being given a chance to respond to any new rejection which might result from such consideration by the examiner) and (iii) furnish applicants with a newly-marked copy of the July 2, 2002 Form PTO-1449 (Modified) bearing the examiner's initials so the record is clear that all of those materials have been considered in the course of examination of this application.

Second, applicants seek either direct action by the Commissioner expunging from the file the examiner's statement made in the September 13, 2001 official action suggesting wrongfully that applicants had submitted deceptive and perhaps outright erroneous information to the USPTO thereby seeking to induce the Office to make false representations to the public, or remand of the application to the examiner with instructions to the examiner to insert a corrective, curative statement into the file making it clear that applicants and applicants' counsel fully complied with the disclosure requirement under 37 CFR 1.56 and the procedural and substantive requirements of 37 CFR 1.97 and 1.98 and did nothing improper in submitting applicants' information disclosure requirement and the two subsequent requests for full consideration of the same.

Third, applicants seek an order suspending the appeal and remanding the application to the examiner with directions to enter and consider on the merits applicants' amendment after final rejection and the declaration evidence submitted therewith addressing the ground of rejection the examiner raised for the first time in making the rejection final.

This Decision is responsive to all three requests and will be treated in the order that the requests were detailed in the PETITION. While 37 CFR 1.181 states that “[a]ny petition...not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely,” the merits of the present PETITION have been fully considered and treated in the Decision below.

## STATEMENT OF FACTS

- 06/23/00 ----- An Information Disclosure Statement listing five references was submitted. Three of the references were cited in the International Search Report of PCT/GB98/01597, which is the International Application of the present National Stage application. The other two references were JP 58-004821A and JP 48-042814B. These two JP publications were not cited on the International Search Report, but their Derwent published English language abstracts were cited on the International Search Report.
- 05/29/01 ----- A first Office action on the merits was mailed. Attached to the Office action was a photocopy of the PTO-1449 submitted by applicants as an attachment to the June 23, 2000 Information Disclosure Statement. On the Form PTO-1449, the citations of the two JP publications were lined-through with a handwritten notation “No copy of patent”.
- 06/22/01 ----- Applicants submitted a Request for Reconsideration of the Information Disclosure Statement. Applicants noted that the Information Disclosure Statement had included a Form PTO-1449 and that the two struck-through JP publications were English-language abstracts. Applicants further noted that these abstracts were cited in the PCT application on which the instant application was based. Applicants stated that no full text translations of the JP publications were readily available and copies of the JP publications were never furnished to the applicants in connection with the International Search Report and hence were not readily available to the applicants.
- 06/28/01 ----- Applicants’ counsel discussed the English-language abstracts of the JP publications with the examiner. In the course of that conversation the examiner suggested that a new PTO-1449 (Modified) be submitted, listing the two previously submitted English-language abstracts of the two JP publications. No Examiner Interview Summary record is present in the present application file.
- 07/02/01 ----- Applicants submitted a Supplement to the Request for Reconsideration of the June 23, 2000 Information Disclosure Statement. The Supplement included a PTO-1449 (Modified) listing only the two JP publications.
- 08/31/01 ----- Applicants submitted an amendment responding to the official Office action of May 29, 2001.
- 09/13/01 ----- A Final Office action was mailed that repeating the art rejection of the first Office action and adding a new matter rejection under 35 USC 112, first paragraph, based on the August 31, 2001 amendment. The Final Office action addressed the Information Disclosure filings of June 28, 2001 and July 2, 2001 by contending that since applicants had represented in the original Information Disclosure Statement that the JP publications were not readily available “there should be no mention of those Japanese patents on the form PTOL-1449.) The Final Office action further included the a statement by the examiner that “the Office will not falsely represent to the public...or anyone...that a document was received and considered...if only an abstract was received and considered.”
- 02/13/02 ----- Applicants submitted a response to the Final Office action that included further amending independent claim 1 and two Declarations filed under 37 CFR 1.132. The response further included a Second

(Supplemental) Information Disclosure Statement and PTO-1449 (Modified) which listed only two one page English language abstracts for the above mention JP publications.

- 03/07/02 ----- An Advisory Action was mailed noting non-entry of the After-Final amendment. The Advisory Action made no mention to the two Declarations filed under 37 CFR 1.132 or of the Information Disclosure Statement of February 13, 2002.
- 03/21/02 ----- Applicants filed a Notice of Appeal.

## DECISION

I. A review of the petitioner's request that the examiner be instructed to fully consider the Information Disclosure Statements of June 23, 2000 and July 2, 2001 cannot be granted for the following reasons.

37 CFR 1.98(a) states:

- (a) Any information disclosure statement filed under § 1.97 shall include:
  - (1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;
  - (2) **A legible copy of:**
    - (i) Each U.S. patent application publication and U.S. and **foreign patent**;
    - (ii) Each publication or that portion which caused it to be listed;
    - (iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
    - (iv) All other information or that portion which caused it to be listed; and
  - (3) (i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.
    - (ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c). (Emphasis added).

As correctly noted by the examiner, the Information Disclosure Statements of June 23, 2000 and July 3, 2001 did not comply with 37 CFR 1.98(a)(2)(i) since no copies of P 58-004821A or JP 48-042814B were submitted by the applicants. The examiner properly followed the procedures set forth in MPEP 609<sup>1</sup> by lining through the citations in these Information Disclosure Statements which did not comply with all of the requirements of 37 CFR 1.97 and 37 CFR 1.98.

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<sup>1</sup> MPEP 609: If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner.

It is noted herein that the present application is a National Stage filing based on PCT/GB98/01597. The international search report for PCT/GB98/01597 did not cite JP 58-004821A or JP 48-042814B, but rather cited Derwent published English language abstracts of these two JP patents.

However, as stated in MPEP 609 (Section II. NATIONAL STAGE APPLICATIONS):

The examiner will consider the documents cited in the International Search Report in a PCT national stage application when the Form PCT/DO/EO/903 indicates that both the International Search Report and the copies of the documents are present in the national stage file. **In such a case, the examiner should consider the documents from the International Search Report and indicate by a statement in the first Office action that the information has been considered.** There is no requirement that the examiner list the documents on a PTO-892 form. (Emphasis added).

Since the PCT/DO/EO/903 indicated that both the International Search Report and the copies of all of the references cited in the International Search Report are present in the national stage file, the examiner erred by not notifying the applicants in the first Office action that the Derwent published English language abstracts of JP 58-004821A or JP 48-042814B were considered by the examiner.

Hence, this part of the PETITION is **denied**. However, upon mailing of this Decision, this application file will be returned to the examiner for prompt preparation and mailing of written confirmation that the Derwent published English language abstracts of JP 58-004821A or JP 48-042814B have been fully considered by the examiner.

II. After a careful review of the application record and the petitioner's argument, it is concluded that the petitioner's request to expunge the examiner's statement is denied in view of the statements made of record in this decision. The Offices procedures for the handling of noncomplying Information Disclosure Statements is set forth in MPEP 609, which states:

**MPEP 609 Section C(1): *Noncomplying Information Disclosure Statements***

Pursuant to 37 CFR 1.97(i), submitted information, filed before the grant of a patent, which does not comply with 37 CFR 1.97 and 37 CFR 1.98 will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with 37 CFR 1.501.

If an information disclosure statement does not comply with the requirements based on the time of filing of the IDS as discussed in subsection III.B above, including the requirements for fees and/or statement under 37 CFR 1.97(e), the IDS will be placed in the application file, but none of the information will be considered by the examiner. The examiner may use form paragraph 6.49 which is reproduced below to inform applicant that the information has not been considered. Applicant may then file a new information disclosure statement or correct the deficiency in the previously filed IDS, but the date that the new IDS or correction is filed will be the date of the IDS for purposes of determining compliance with the requirements based on the time of filing of the IDS (37 CFR 1.97). The examiner should write "not considered" on an information disclosure statement

where none of the information listed complies with the requirements, e.g., no copies of listed items submitted. If none of the information listed on a PTO-1449 or PTO/SB/08A and 08B form is considered, a diagonal line should also be drawn in pencil across the form and the form placed on the right side of the application file to instruct the printer not to list the information on the face of the patent if the application goes to issue. The paper containing the disclosure statement or list will be placed in the record in the application file. The examiner will inform applicant that the information has not been considered and the reasons why using form paragraphs 6.49 through 6.49.09. If the improper citation

appears as part of another paper, e.g., an amendment, which may be properly entered and considered, the portion of the paper which is proper for consideration will be considered. If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner.

If information listed in the specification rather than in a separate paper, or if the other content requirements as discussed in subsection III.A above are not complied with, the information need not be considered by the examiner, in which case, the examiner should notify applicant in the next Office action that the information has not been considered.

The procedure set forth in MPEP 609 does NOT guide or permit the examiner to make comments regarding any representation to "the public...or anyone" regarding the receipt or non-receipt of any document(s). As noted by the petitioner, such a statement could be interpreted as though the applicants and/or applicants' counsel submitted deceptive or fraudulent information to the Office. Certainly, it is clear from the record, including the present Petition and Supplemental Information Disclosure Statement of February 13, 2002, that the applicants intention throughout the entire prosecution of this application was simply to have those documents which were cited on the International Search Report in PCT/GB98/01597 made of record in the present application file wrapper. MPEP 707.07(d) indicates that "[e]verything of a personal nature must be avoided [in examiner Office actions]." The Office apologizes for the Examiners inappropriate comments made in the Office action of September 13, 2001 (Paper No. 10). The Examiner's statement regarding the Office's representation to "the public...or anyone" regarding the non-receipt of two JP publications were not only improper in accordance with the guidelines set forth in MPEP 609, but also grossly erroneous and wrongfully prejudicial based on the fact that applicants' counsel has attempted numerous times to submit an Information Disclosure Statement which would both (1) be considered by the examiner and (2) comply with 37 CFR 1.98. In view of this clarification, this part of the PETITION is dismissed.

The petitioner alternatively requested that the examiner be instructed to insert a corrective, curative statement into the file making it clear that applicants and applicants' counsel fully complied with the disclosure requirement under 37 CFR 1.56 and the procedural and substantive requirements of 37 CFR 1.97 and 1.98 and did nothing improper in submitting applicants' information disclosure requirement and the two subsequent requests for full consideration of the same. For the reasons stated above in Section I of this Decision, the Office is unable to make such a statement on the record. Accordingly, this part of the PETITION is denied.

III. The Advisory Action of March 8, 2002 stated that entry of the after final amendment of February 26, 2002 was denied because: (1) there was no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented; (2) the amendment raised new issues that would require further consideration and/or search; and (3) the amendment was not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. The examiner's noted that "[t]he new issue is if the amendment would make the claims allowable."

MPEP 714.13 states:

In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. **The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.** Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons for nonentry should be concisely expressed. For example:

- (A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.
- (B) The claims, if amended as proposed, would raise the issue of new matter.
- (C) The claims as amended present new issues requiring further consideration or search.
- (D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. Ex parte Wirt, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Examiners should indicate the status of each claim of record or proposed in the amendment, and which proposed claims would be entered on the filing of an appeal if filed in a separate paper.

Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments. Similarly, if the proposed amendment to some of the claims would render them allowable, applicant should be so informed. This is helpful in assuring the filing of a brief consistent with the claims as amended. A statement that the final rejection stands and that the statutory period runs from the date of the final rejection is also in order.

**Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal.** (Emphasis added).

While 37 CFR 1.116 specifies that applicants cannot, as a matter of right, amend any finally rejected claims, the procedures of MPEP 714.13 requires the examiner to determine whether the amendment places the application in condition for allowance or in better form for appeal. Clearly the examiner failed to do this in the present case, since the examiner's reasoning was that the new issue was whether the amendment made the claims allowable or not. Additionally, the examiner failed to mention or consider the two Declaration filed under 37 CFR 1.132 submitted in the February 13, 2002 response and the Information Disclosure Statement filed in the February 13, 2002 response. Nevertheless, it appears as though the amendment of February 13, 2002 does indeed raise new issues regarding the newly added claim limitation regarding the "dissolution rate." Accordingly, upon the mailing of this Decision, this case will be forwarded to the examiner for prompt full consideration, which is in full compliance with the procedures detailed in MPEP 714.13, of the after final response of February 13, 2002, including the amendment, Declarations under 37 CFR 1.132, and the Supplemental Information Disclosure Statement. A Notice of Allowance, Office action on the merits or Advisory Action will follow in due course. Such a communication will contain written confirmation that the Derwent published English language abstracts of JP 58-004821A or JP 48-042814B have been fully considered by the examiner (see Decision Part I). This part of the PETITION is dismissed.

After the mailing of this decision, this application shall be returned to the examiner for preparation of a written communication (see Decision Part III), which shall follow in due course. The Appeal Brief filed on September 3, 2002 will also be entered and acted on in due course, if appropriate.



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